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10/564,248	01/11/2006	Hideharu Yoneoka	590157-2033	8013

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EXAMINER	
WASHINGTON, JAMARES	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/564,248	YONEOKA, HIDEHARU	
	Examiner	Art Unit	
	JAMARES WASHINGTON	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 January 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Amendments and response received January 27, 2009 have been entered. Claims 1-7 are currently pending in this application. Claims 1-4 have been amended and claims 6 and 7 newly added by this amendment. Amendments and response are addressed hereinbelow.

Claim Objections

In light of the amendments to claims 1-4, Examiner withdraws previous objections.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robert Templeton (US 6152029) in view of David Kloosterman et al (US 7375842 B2).

Regarding claim 1, Templeton discloses an image forming system which is for forming a fixed image on one of the sides of a plurality of recording media and variable images different from each other on the other of the sides of the recording media (Fig. 2 electronic control system. Col. 1 lines 41-46 wherein fixed data is printed on one side of the medium and variable data printed on the other side of the medium) comprising:

a printing information output unit (Fig. 2 numeral 200 which, according to Col. 3 lines 36-38, can be housed in a personal computer) which outputs fixed image data representing the fixed image and a plurality of pieces of variable image data each representing a variable image (Col. 3 lines 38-51 wherein the data controller outputs the fixed and variable data to the inkjet printers (A and B) shown in Fig. 2 numerals 30 and 32);

an image forming apparatus which forms images on opposite sides of the recording media on the basis of the fixed image data and the variable image data output from the printing information output unit (Col. 1 lines 41-46 wherein a 6 color offset printing unit and inkjet printers are used as the output devices).

Templeton fails to disclose or fairly suggest a storage portion which is provided in the image forming apparatus to store the fixed image data output from the printing information output unit,

a printing information output control means which causes the storage portion to store the fixed image data output from the printing information output unit and to hold the stored fixed image data until it is used for image formation of the fixed image on a plurality of recording media.

Kloosterman et al, in the same field of endeavor of printing fixed and variable image data wherein the fixed image data is saved for re-use (Col. 2 lines 19-42 wherein "re-used" elements read on "fixed" image data), teaches a storage portion which is provided in the image forming apparatus to store the fixed image data output from the printing information output unit (Col. 2 lines 38-42 wherein the "fixed" data is stored in cache), a printing information output control means (PPML RIP (raster image processor) described in Col. 2 lines 43-45) which causes the storage portion to store the fixed image data output from the printing information output unit and to hold the stored fixed image data until it is used for image formation of the fixed image on a plurality of recording media (Col. 2 lines 43-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the invention of Templeton wherein a system for forming a fixed image on one side of a plurality of recording media and variable images different from each other on the other side of the recording media is disclosed to utilized the teachings of Kloosterman et al wherein a storage portion which is provided in the image forming apparatus to store the fixed image data and a printing information output control means which causes the storage portion to store the fixed image data because the "ability to re-use "fixed" elements eliminates the need to resend the source code that defines the content element to the printer/RIP multiple times during the same print job" (Col. 2 lines 45-48, Kloosterman et al).

Templeton also fails to explicitly disclose an image formation control means which controls the image forming apparatus to read out the fixed image data held in the storage portion to form fixed images on one side of a plurality of recording media and to receive a plurality of

pieces of the variable image data output from the printing information output unit to form variable images on the other side of a plurality of the recording media.

However, combining the disclosure of Templeton wherein image data is read out to form fixed images on one side of a plurality of recording media and to receive a plurality of pieces of the variable image data output from the printing information output unit to form variable images on the other side with the teachings of Kloosterman et al wherein a storage portion stores the fixed image data would result in the control means which controls image formation in the disclosure of Kloosterman et al (Raster Image Processor as mentioned before) to read out the fixed image data held in the storage to print fixed data on one side of a print medium and variable data on the other side of the print media. The modification of Templeton to use the storage and control means as disclosed by Kloosterman et al would have constituted the mere arrangement of old elements with each performing the same function it had been known to perform, the combination yielding no more than one would expect from such an arrangement. The Court has held that a "patent for a combination which only unites old elements with no change in their respective functions.., obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men." Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147, 152 (1950). This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.

Templeton fails to explicitly disclose wherein the printing information output unit attaches identifying data that indicates that data is the fixed image data when outputting the fixed image data; and

wherein the printing information output control means recognizes image data output from the printing information output unit, to which the identifying data is attached, as the fixed image data, and causes the fixed image data to be stored in the storage portion.

Kloosterman et al teaches attaching identifying data that indicates that data is the fixed image data when outputting the fixed image data (Col. 2 lines 31-37 wherein PPML is structured in a way that content data that is used multiple times is explicitly identified so as to enable a RIP process opportunities for improved processing. Leading one of ordinary skill in the art to believe the fixed image data is tagged with attached identifying information) wherein the printing information output control means recognizes image data output from the printing information output unit, to which the identifying data is attached, as the fixed image data, and causes the fixed image data to be stored in the storage portion (Col. 2 lines 38-42 wherein the re-used image data is stored after they are first RIPed and then reused as raster data).

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the printing information output control means as disclosed by Templeton to implement the technique as taught by Kloosterman et al wherein identifying data is attached that indicates that data is the fixed image data when outputting the fixed image data and wherein the printing information output control means recognizes image data output from the printing information output unit, to which the identifying data is attached, as the fixed image data, and causes the fixed image data to be stored in the storage portion to allow the printer/RIP to have a

certain degree of intelligence to understand at an object level rather than a page level to aid in the manipulation of the objects of a page to be printed.

Regarding claim 3, Templeton discloses an image forming apparatus which is for an image forming system defined in claim 1 (see rejection of claim 1) further comprising:

a storage portion which stores the fixed image data output from the priming information output unit (see rejection of claim 1 wherein the storage is located within the image forming apparatus), and

an image formation control means which controls the image forming apparatus to read out the fixed image data held in the storage portion to form fixed images on one of the sides of a plurality of recording media and to receive a plurality of pieces of the variable image data output from the priming information output unit to form variable images on the other side of a plurality of the recording media (see rejection of claim 1).

3. Claims 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Templeton in view of Kloosterman et al as applied to claim 1 above, and further in view of Val Skordin et al (WO 03/036430 A2).

Regarding claim 2, Templeton discloses an image forming system as defined in Claim 1.

Templeton fails to expressly disclose or fairly suggest wherein the printing information output unit displays in a list a plurality of pieces of information representing a plurality of pieces of fixed image data which are stored in advance, and at the same time, has a fixed image

selecting means through which image data representing a fixed image to be formed on said one of the sides of the recording media can be selected out of the plurality of fixed image data.

Skordin et al, in the same field of endeavor of creating forms utilizing fixed and variable data for output (Abstract), teaches wherein the printing information output unit (see rejection of claim 1 wherein the information output unit is embodied within a computing environment) displays in a list a plurality of pieces of information representing a plurality of pieces of fixed image data which are stored in advance, and at the same time, has a fixed image selecting means (Fig. 3 numeral 66 in which a "document" is selected from a document catalog. Fig. 2 explains how the "documents" are created and stored in advance. Page 7, ¶ [2] lines 3-7 explain the "documents" which are selectable contain static source text and graphics, which read on fixed data. See page 14, ¶ [3] lines 1-3 wherein the document data is combined with the variable data to provide a printed usable form) through which image data representing a fixed image to be formed on said one of the sides of the recording media can be selected out of the plurality of fixed image data (see rejection of claim 1 wherein the fixed image data is printed on one side of the recording media).

It would have been obvious to one of ordinary skill in the art at the time the invention was made for the invention as disclosed by Templeton wherein image data is read out to form fixed images on one side of a plurality of recording media and to receive a plurality of pieces of the variable image data output from the printing information output unit to form variable images on the other side to utilize the teachings of Skordin et al wherein the printing information output unit displays in a list, a plurality of pieces of information representing a plurality of pieces of fixed image data which are stored in advance, and at the same time, has a fixed image selecting

means through which image data representing a fixed image to be formed on said one side of the recording media can be selected out of the plurality of fixed image data because allowing the fixed image data to be selected from a list of fixed image data creates ease of use for the user and eliminates the need for the user to enter the static or fixed image data on every occasion the document is needed.

Regarding claim 4, Templeton discloses an image forming system which is for forming a fixed image on one of the sides of a plurality of recording media and variable images different from each other on the other of the sides of the recording media comprising:

a computer which outputs variable image data representing the variable image of a plurality of pages (see rejection of claim 1);

a controller which is provided with a variable image data receipt portion which receives the variable image data output from the computer and an image storage portion which stores a plurality of pieces of fixed image data each representing a fixed image (see rejection of claim 1 wherein the control means receives the variable image data from the computer therefore there must exist a variable image data receipt portion along with the storage portion as rejected in claim 1 above.), and outputs the variable image data received by the variable image data receipt portion and a fixed image data stored in the image storage portion; and

a printer which forms images on opposite sides of the recording media on the basis of the fixed image data and the variable image data output from the controller (see rejection of claim 1 above),

wherein the computer outputs to the controller fixed image designation information for designating one of the plurality of pieces of fixed image data (see rejection of claim 2 wherein the document is selected by the user),

wherein the controller selects one of the plurality of pieces of fixed image data from the image storage portion on the basis of the fixed image designation information output from the computer and outputs the selected fixed image data to the printer and thereafter outputs the variable image data of the plurality of pages to the printer (see rejection of claim 2 wherein the fixed static information of the selected document is combined with the variable data for print output),

wherein the printer is provided with a storage portion which stores the fixed image data output from the controller, a printing information output control means which causes the storage portion to store the fixed image data and to hold the stored fixed image data until it is used for image formation of the fixed image on a plurality of recording media (see rejection of claim 1), and an image formation control means which controls the image forming apparatus to read out the fixed image data held in the storage portion to form fixed images on one of the sides of a plurality of recording media and to receive a plurality of pieces of the variable image data output from the controller to form variable images on the other side of a plurality of the recording media (see rejection of claim 1 wherein the printing output control means controls the image forming apparatus to implement the method as rejected in claim 1 above);

wherein the controller attaches identifying data that indicates that data is the fixed image data when outputting the fixed image data (see rejection of claim 1); and

wherein the printing information output control means recognizes image data output from the printing information output unit, to which the identifying data is attached, as the fixed image data, and causes the fixed image data to be stored in the storage portion (see rejection of claim 1).

Regarding claim 5, Templeton discloses an image forming system as defined in Claim 4 in which the controller and the printer is formed integrally with each other (see rejection and explanation of motivation of claim 1 for modifying the invention of Templeton with the control means provided by Kloosterman et al).

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Templeton in view of Kloosterman et al as applied to claim 1, and further in view of Ghilad Dziesietnik et al (US 6134018).

Regarding claim 6, Templeton discloses an image forming system as defined in claim 1.

Templeton fails to disclose or fairly suggest wherein the identifying data is data that indicates a page number of zero.

Dziesietnik et al, in the same field of endeavor of printing utilizing variable and fixed image data (Abstract), teaches identifying data is data that indicates a page number (Col. 7 lines 15-23 wherein fixed data in the form of a master document includes a tag uniquely identifying it to the system, including the particular page number).

Although Dziesietnik et al does not disclose the page number being zero, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the invention as disclosed by Templeton et al wherein identifying data is attached to fixed image data to utilize the teachings of Dziesietnik et al wherein the identifying data is a page number to use zero as the master document page number. A person of ordinary skill in the art would have had good reason to pursue the known options of providing zero as the page number for the master copy when using the page number as the identifier because it would require no more than "ordinary skill and common sense" to start the numbering of the pages of fixed image data with zero. Choosing from a finite number of identified, predictable solutions (i.e. numbers), it would have been obvious to start with zero as the first page number as the numbering system starts with zero.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Templeton in view of Kloosterman et al and Skordin et al as applied to claim 4 above, and further in view of Dziesietnik et al.

Regarding claim 7, Templeton discloses an image forming system as defined by claim 4 (see rejection of claim 4) wherein:

the identifying data is data that indicates a page number of zero (see rejection of claim 6).

Response to Arguments

6. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's arguments filed January 27, 2009 have been fully considered but they are not persuasive.

Applicant's remarks: The "documents" disclosed in Skordin are completely different from the fixed image data of the invention defined in claim 2. Therefore, Skordin fails to teach or suggest storing a plurality of fixed image data that represent fixed images to be formed on one of the sides of a plurality of recording media, displaying the plurality of fixed image data in a list, and enabling selection of a piece of fixed image data from among those in the list.

8. Examiner's response: The documents as taught by Skordin et al, represent fixed image data (i.e., templates). "Pieces of fixed image data" are clearly read on by the portion of Skordin et al wherein documents which are stored are templates of fixed "static source text and graphics" as cited above in the rejection of claim 2. Furthermore, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. The prior art reference (or references when combined) need not teach or suggest all the claim limitations, however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. The "mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness." Dann v. Johnston, 425 U.S. 219, 230, 189 USPQ 257, 261 (1976). The gap between the prior art and the claimed invention may not be "so great as to render the [claim] nonobvious to one reasonably skilled in the art." Id. In determining obviousness, neither the particular motivation to make the claimed invention nor the problem the inventor is solving controls. The proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. See 35 U.S.C. 103(a). Factors other than the disclosures of the cited prior art may provide a basis for concluding that it would have been obvious to one of ordinary skill in the art to bridge the gap. Clearly, one of ordinary skill in the art would ascertain that the "documents" as disclosed by Skordin et al could easily translate to "fixed image data" as claimed.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMARES WASHINGTON whose telephone number is (571) 270-1585. The examiner can normally be reached on Monday thru Friday: 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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April 30, 2009